

REMARKS/ARGUMENTS

This Reply is being filed in response to the final Official Action of August 23, 2007. Initially, Applicant appreciates the Examiner and his supervisor taking the time to conduct a telephone interview with Applicant's undersigned attorney regarding the final Official Action. The final Official Action no longer rejects any of the claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2006/0025141 to Marsh et al., in view of U.S. Patent Application Publication No. 2003/0154293 to Zmolek, alone or further in view of U.S. Patent Application Publication No. 2004/0024879 to Dingman et al. Instead, the final Official Action now rejects a number of the pending claims under 35 U.S.C. § 102(e) as being anticipated by newly-cited U.S. Patent No. 7,177,636 to Oda et al., and rejects the remaining claims as being unpatentable over Oda, in view of either Zmolek or Dingman. That is, the final Official Action rejects Claims 1-3, 5, 7-13, 16-22, 25-31, 34-40, 43-49 and 52-54 as being anticipated by Oda; and rejects the remaining claims, namely Claims 4, 6, 14, 15, 23, 24, 32, 33, 41, 42, 50 and 51, as being unpatentable over Oda, in view of either Zmolek or Dingman (noting that the Official Action indicates Claim 6 is rejected as being anticipated by Oda, but substantively addresses Claim 6 as being unpatentable over Oda, in view of Dingman).

As described below in detail, Applicant respectfully submits that the Examiner prematurely issued a final Official Action due to the introduction of the new grounds of rejection. As also described below, Applicant respectfully submits that the claimed invention is patentably distinct from Oda, Zmolek and Dingman, taken individually or in combination. Accordingly, Applicant respectfully traverses the finality of the present Official Action, as well as the rejections of the claims as being anticipated by Oda, or as being unpatentable over Oda in view of either Zmolek or Dingman. In view of the remarks presented herein, Applicant respectfully requests reconsideration of the present application and allowance of the pending set of claims, or in lieu thereof at least withdrawal of the finality of the present Official Action. Should the Examiner maintain the finality of the Official Action, however, Applicant respectfully requests entry of this Reply for purposes of narrowing the issues upon appeal as the remarks presented herein do not raise any new issues or introduce any new matter.

I. Finality of the Official Action is Premature

In the first Official Action dated March 6, 2007, the Examiner rejected Claims 1-5, 7-14, 16-23, 25-32, 34-41, 43-50 and 52-54 under 35 U.S.C. § 103(a) as being unpatentable over Marsh, in view of Zmolek. As to original independent Claims 1, 19, 28, 37 and 46, the first Official Action appeared to allege that Marsh, in view of Zmolek, teach triggering the terminal “independent of the location of an originating entity.” In Applicant’s response to the first Official Action, however, Applicant traversed this rejection and noted that original independent Claims 10, 19, 28, 37 and 46 do not recite triggering the terminal independent of the location of an originating entity, but instead recite triggering the terminal or identifying the terminal “independent of the network” for which a communication session may ultimately be established. As independent Claim 1 did erroneously refer to the location of the originating entity, Applicant did amend independent Claim 1 consistent with original independent Claims 10, 19, 28, 37 and 46. Applicant did not, however, amend any of independent Claims 10, 19, 28, 37 and 46 as to this recited feature (noting that those claims were amended in other respects, including a change of “capable of” language to “configured to” language).

Now, in the final Official Action, the Examiner no longer rejects any of independent Claims 10, 19, 28, 37 and 46 as being unpatentable over Marsh in view of Zmolek. Instead, the final Official Action rejects all of those independent claims, as well as independent Claim 1, under 35 U.S.C. § 102(e) as being anticipated by newly-cited Oda, alleging that Oda teaches the very features the first Official Action attributed to Marsh, in view of Zmolek.

In accordance with MPEP § 706.07(a), a second or subsequent Official Action shall be made final, “except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p).” In the instant case, the Examiner in the final Official Action alleges that the newly-cited Oda discloses the feature of triggering the terminal or identifying the terminal “independent of the network” for which a communication session may ultimately be established, per original and currently-pending independent Claims 10, 19, 28, 37 and 46. By this change with respect to at least independent Claims 10, 19, 28, 37 and 46, the Examiner has

introduced a new ground of rejection neither necessitated by Applicant's claim amendments presented in response to the first Official Action, nor based on information submitted in an IDS filed after that Official Action. While Applicant does acknowledge amending independent Claims 10, 19, 28, 37 and 46, Applicant respectfully submits that none of the amendments made to any of those claims "necessitated the new ground(s) of rejection" in the final Official Action.

Applicant therefore respectfully submits that in the current Official Action, the Examiner introduced a new ground of rejection that was neither necessitated by Applicant's amendment of at least independent Claims 10, 19, 28, 37 and 46 nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c). Applicant also respectfully submits that, in accordance with MPEP § 706.07(a), the Examiner prematurely issued a final Official Action. Accordingly, Applicant respectfully requests withdrawal of the finality of the current Official Action.

II. The Claimed Invention is Patentable over the Cited References

Various ones of the claims of the present application are separately rejected as being anticipated by Oda, or as being unpatentable over Oda in view of either Zmolek or Dingman. Accordingly, the rejections of the claims will be separately addressed below in a similar fashion.

A. Claims 1-3, 5, 7-13, 16-22, 25-31, 34-40, 43-49 and 52-54 are Patentable

The final Official Action rejects Claims 1-3, 5, 7-13, 16-22, 25-31, 34-40, 43-49 and 52-54 as being anticipated by Oda. Briefly, newly-cited Oda discloses a system and method for registering the location of a radio terminal in a cellular network, where the registration is effectuated across an IP network. As disclosed, a radio terminal formulates an IP packet including a location registration message for a cellular network, and sends the message to a control proxy server (radio terminal controlling apparatus) via an IP network. The control proxy server stores a correspondence between identification information on a radio terminal and an IP address based on a location registration request. If necessary, a gateway (location registration auxiliary apparatus) converts the location registration request into the location registration message in compliance with a standard of the cellular network. The location registration

message is transferred to an MSC/VLR in the cellular network via the gateway, where the MSC/VLR registers the location of the radio terminal in the cellular network in response to the location registration message.

According to a first aspect of the present invention, as reflected by independent Claim 1, an apparatus is provided for establishing a communication session with a terminal. As recited, the apparatus includes a processor located in a network across which an originating client is capable of communicating. The processor is configured to receive a connection request, and thereafter send a trigger to the terminal independent of the network. As also recited, the processor is configured to receive a registration message in response to the trigger to thereby register the terminal with the processor, and identify the terminal across the network such that the communication session is capable of being established with the terminal based upon the identity of the terminal across the network.

According to a second aspect of the present invention, as reflected by independent Claim 10, an apparatus for establishing a communication session with a terminal again includes a processor. As recited, similar to independent Claim 1, the processor is located in a network across which an originating client is capable of communicating. The processor is configured to receive a registration message to thereby register the terminal with the processor. In this regard, the registration message includes an identifier of the terminal independent of the network. The processor is therefore configured to trigger the terminal independent of the network based upon the identifier of the terminal to thereby identify the terminal across the network such that the communication session is capable of being established with the terminal based upon the identity of the terminal across the network.

In contrast to the first aspect of the present invention (and, e.g., independent Claim 1 in particular), none of Oda, Zmolek or Dingman, taken individually or in any proper combination, teach or suggest an apparatus (or processor thereof) triggering a terminal (independent of a network) to thereby register with the apparatus and identify the terminal across the network so that a communication session may be established with the terminal across the network. That is, in contrast to independent Claim 1, none of Oda, Zmolek or Dingman, taken individually or in any proper combination, teach or suggest an apparatus including a processor configured to

trigger a terminal independent of a network across which an originating client communicates, the terminal being triggered to thereby register with the processor and identify the terminal across the network so that a communication session may be established with the terminal based on the identity of the terminal across the network.

Further, and in contrast to the second aspect of the present invention (and, e.g., independent Claim 10 in particular), none of Oda, Zmolek or Dingman, taken individually or in any proper combination, teach or suggest receiving a registration message including an identifier of a terminal independent of the network so that the terminal may be triggered based on the identifier in a manner similar to that recited by independent Claim 1. More particularly, none of Oda, Zmolek or Dingman, taken individually or in any proper combination, teach or suggest a network node including a processor configured to receive a registration message including an identifier of the terminal independent of the network, the processor being configured to trigger the terminal independent of the network based on the identifier to thereby identify the terminal across the network so that the communication session may be established with the terminal based upon the identity of the terminal across the network.

The final Official Action cites Oda as allegedly anticipating both aspects of the present invention. In this regard, Oda discloses a radio terminal sending a location registration message for a cellular network in an IP packet via an IP network, where the IP packet may include a cellular network identifier as well as an IP address of the radio terminal. However, Oda does not teach or suggest an apparatus including a processor that registers a terminal, and that also sends a trigger or otherwise triggers the terminal independent of a network to thereby identify the terminal across the network such that a communication session may be established with the terminal based on the identity of the terminal across the network. To the extent that the location registration message of Oda is interpreted as a registration of a terminal similar to the claimed invention, we note that nowhere does Oda teach or suggest that its terminal receives a trigger or is otherwise triggered to send the location registration by any registering apparatus. Rather, Oda explicitly discloses that the decision to send the location registration is made local to the radio terminal based on a comparison of cellular-network signal strength to a threshold. Oda, col. 7, l. 44 – col. 8, l. 7; and col. 8, ll. 39-41.

Applicant therefore respectfully submits that independent Claim 1, and by dependency Claims 2-9, is patentably distinct from Oda. Applicant also respectfully submit that independent Claims 10, 19, 28, 37 and 46 recite subject matter similar to that of independent Claim 1, including the aforementioned triggering the terminal (or an apparatus) or identifying the terminal (or an apparatus) independent of the network for which a communication session may ultimately be established. As such, Applicant also respectfully submit that independent Claims 10, 19, 28, 37 and 46, and by dependency Claims 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Oda for at least the same reasons given above with respect to independent Claim 1.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of Claims 1-3, 5, 7-13, 16-22, 25-31, 34-40, 43-49 and 52-54 as being anticipated by Oda is overcome.

B. Claims 4, 6, 14, 15, 23, 24, 32, 33, 41, 42, 50 and 51 are Patentable

The Official Action also rejects Claims 4, 6, 14, 15, 23, 24, 32, 33, 41, 42, 50 and 51, as being unpatentable over Oda, in view of either Zmolek or Dingman. As explained above, independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Oda. Applicant respectfully submits that neither Zmolek nor Dingman, taken individually or in combination, cures the deficiencies of Oda. That is, even considering Zmolek and Dingman, none of Oda, Zmolek or Dingman, taken individually or in combination, teaches or suggests the aforementioned terminal-triggering feature, as recited by the claimed invention. And one skilled in the art still would not be motivated to modify Oda with the teachings of Zmolek and/or Dingman to disclose the claimed invention. For example, given that Oda discloses that its control proxy server is located in a LAN of the user of the radio terminal, Applicant respectfully submits that one skilled in the art would not in fact have been motivated to modify Oda to include a firewall or NAT between the control proxy server and radio terminal, as alleged in the Official Action to support a rejection of Claims 6, 15, 24, 33, 42 and 51. Thus, for at least the foregoing reasons as well as those given above with respect to independent Claims 1, 10, 19, 28, 37 and 46, Claims 6, 15, 24, 33, 42 and 51 are also patentably distinct from Oda in view of either Zmolek or Dingman.

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Reply to Official Action of August 23, 2007


Applicant accordingly submit that the rejection of Claims 4, 6, 14, 15, 23, 24, 32, 33, 41, 42, 50 and 51, as being unpatentable over Oda, in view of either Zmolek or Dingman, is overcome.

CONCLUSION

In view of the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues. As explained above, no new matter or issues are raised by this Reply, and as such, Applicant alternatively respectfully request entry of this Reply for purposes of narrowing the issues upon appeal.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,


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